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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,034	09/22/2003	James D. Ralph	F-295	1511
<div>51640 7590 02/05/2007</div> <div>SPINE MP</div> <div>LERNER, DAVID, et al.</div> <div>600 SOUTH AVENUE WEST</div> <div>WESTFIELD, NJ 07090</div>				
			<div>EXAMINER</div> <div>SHAFFER, RICHARD R</div>	
			<div>ART UNIT</div> <div>3733</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>02/05/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/667,034

Applicant(s)

RALPH ET AL.

Examiner

Richard R. Shaffer

Art Unit

3733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 04 January 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 6-11 and 13.
Claim(s) withdrawn from consideration: 5 and 12.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER

Richard Shaffer
1/30/07

Continuation of 11. does NOT place the application in condition for allowance because: The amendment to claim 8 corrects a typographical error therefore putting the claims in better condition for appeal. Therefore the amendment has been entered. However, applicant's arguments directed towards the allowability of the claims is not found persuasive. Applicant argues that the examiner has employed hindsight in using the flat center upper surface teaching of Michelson with the intervertebral implant of Gross et al further stating that Michelson states no such suggestion or motivation to combine.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the upper surface of Gross is already substantially flat across the entire surface except for the dome portion. From Gross et al, it is BOTH (Column 3, Line 60 through Column 4, Line 5) the protrusions (5, 6) and the domes (3, 4) that hold the device in place. But primarily the protrusions are what hold against dislocations and rotational movements (Column 1, Lines 60-62). The dome is mainly for centering purposes and therefore not critical in the overall function of the device. Michelson teaches an intervertebral implant with flat surfaces (or convex in nature, but not a convex protrusion per se) which clearly further demonstrates the non-criticality of a central protrusion for holding an implant and also shows that it is not needed for insertion stating that standard surgical techniques are employed (according to the incorporation by reference of application 08/263,952) which can reasonably be interpreted as including x-ray guidance to assure proper centering. As mentioned previously, a flat surface rather than an abrupt protrusion would facilitate insertion into the disc space which is alluded to through Michelson in terms of ease of insertion with wedge shape, expandable inserts, and avoiding inserting too tall of an implant as the leading edge.

In regard to Gross et al in view of Michelson not including "two relative angle designation marks as recited in claims 3, 8, 11 and 13, as previously explained in the Office Actions, the domes were an example given due to the broad claim language. Every radially extending line separating the 12 segments as shown in Figure 2 could be considered angle designation marks, as well as other shapes such as the cutout portion (12) as seen in Figure 4b.